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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,791	12/03/2003	Thomas J. Bate	10253/15	6801
757	7590	07/23/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			HU, HENRY S	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/727,791	Applicant(s) BATE, THOMAS J.	
	Examiner Henry S. Hu	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. **Claims 1-19 are pending** now, wherein Claims 1, 6 and 13 are independent claims. An action follows.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. **Claims 1-15**, drawn to a non-stick coating formulation comprising an acrylic polymer, an alcohol and a fluoropolymer, classified in class 524, subclass 544.
  - II. **Claims 16-31**, drawn to a non-stick coating comprising a fluoropolymer and an acrylic polymer cross-linked with an alcohol, classified in class 442, subclass 59+.
  - III. **Claims 32-50**, drawn to a process for making a non-stick coating, which comprising an acrylic polymer, an alcohol and a fluoropolymer, on substrate, classified in class 526, subclass 89.
3. The inventions are distinct, each from the others because of the following reasons:  
**Inventions I and II are unrelated.** Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different same

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). Although the compounds in both invention groups use an acrylic polymer, an alcohol and a fluoropolymer, they are actually quite different polymers in view of the structure as well as the performance properties **due to the crosslinking limitation between acrylic polymer and alcohol**. The process of making is unique and thereby not interchangeable.

4. **Inventions III and II** are related as process of making and product made, while **Inventions III and I** are related as process of using and product used. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can use or can be used to make other and materially different product or (2) that the product as claimed can be made or used by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different polymer or copolymer, the requirement is the all polymers are compatible with other components.

In the instant case Group I was drawn to a non-stick coating formulation comprising an acrylic polymer, an alcohol and a fluoropolymer, Group II was drawn to a non-stick coating comprising a fluoropolymer and an acrylic polymer **cross-linked with an alcohol**, while Group III was drawn to a process for making a non-stick coating, which comprising an acrylic polymer. Therefore, the scope of the claims, i.e., the metes and boundaries are distinct.

5. In the instant case, both acrylic polymers and fluoropolymers as mentioned in Invention I, II and III, each may contain some components from other Inventions. However, **the**

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**individual property of polymers will not be shown in its polymeric composition mainly due to the fact that crosslinking may be existed between acrylic polymer and alcohol.** Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that no phone call was made to **G. Peter Nichols or Mark Remus (tel: 312 321-4200)** by the examiner due to the complexity. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

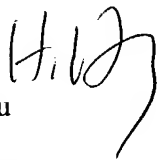
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***Conclusion***


8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Henry S. Hu whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry S. Hu

July 13, 2004

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700